

REMARKS

Claims 1-26 are pending in the present application.

At the outset, Applicants wish to thank Examiner Haq for recognizing the Claims 2-14 are free from the art of record. Reconsideration of the outstanding rejections is requested in view of the following.

The rejection of Claims 1-26 under 35 U.S.C. §112, second paragraph, is obviated in part by amendment and traversed in part.

With respect to items 5, 6, 7, and 9 on page 2 of the outstanding Office Action, Applicants submit that the claims have been amended to ensure proper antecedent basis for the objected terms. As such, these various points of criticism are believed to be moot.

Turning to item 3 on page 2 of the outstanding Office Action, Applicants submit that the term “silylated organic compound” is perfectly clear to the skilled artisan. It is widely accepted in the present art to define a compound by its main functional groups. This convention is demonstrated in the “Handbook of Analytical Derivatization Reaction” by Daniel R. KNAPP (“AAA”) on page 8. Further, it should be noted that the Office has already recognized the sufficiency of such a term in other applications, see for example U.S. 4,808,741 and U.S. 4,680,710. Therefore, Applicants submit that the term “silylated organic compound” is definite and no further amendment is believed to be necessary.

In item 4 of the outstanding Office Action, the Examiner alleges that Claim 1 has omitted an essential step. The step that the Examiner alleges is missing is a “detecting and/or measuring step for the appearance of desilylated organic compound or disappearance of silylated organic compound.” However, Applicants respectfully direct the Examiner’s

attention to the second step in Claim 1, which already recite the allegedly missing language. Therefore, it is submitted that Claim 1 has not omitted an essential step.

Finally, with respect to item 8 in the outstanding Office Action, Applicants submit that the term “means for detecting” is perfectly clear and readily understood to the skilled artisan. This is especially true when the claims are read in view of the specification. The Examiner’s attention is directed to MPEP §2173.02, which states:

Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

Applicants submit that the artisan would readily understand the meaning of the term “means for detecting” by referring to page 3, line 34 to page 4, line 18, as well as the remaining description of the present application and the Examples therein.

In view of the foregoing, withdrawal of this ground of rejection is requested.

The rejection of Claims 1-2 under 35 U.S.C. §112, first paragraph (enablement), is respectfully traversed.

The Office has taken the position that the claimed invention is not supported by an enabling disclosure (see item 11 in the outstanding Office Action). Applicants respectfully disagree and submit that the the basic inventive concept underlying the present invention is the use of an organic compound including a silyl group whatever the rest of the organic molecule can be.

MPEP § 2164.04 states:

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided

for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)

Applicants submit that the Examiner has not provided any reason and/or explanation for rejecting these claims as lacking enablement. The Examiner has merely stated a conclusion that “there is no enablement in the specification for use of all organic compound[s] for “R<sup>4</sup>”.” Accordingly, the rejection of Claims 1-2 under 35 U.S.C. §112, first paragraph, is not tenable and must be withdrawn.

Moreover, Applicants remind the Examiner that MPEP § 2164.01 states:

The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

Applicants submit that the skilled artisan would readily appreciate, with the present specification in hand, the operability of the claimed invention for any organic compound including a silyl group whatever the rest of the organic molecule may be. There being no evidence or explanation by the Examiner to suggest otherwise, Applicants submit that this ground of rejection is without merit.

Based on the foregoing, Applicants submit that the present claims are fully enabled by the specification and the common knowledge available in the art and as such withdrawal of this ground of rejection is requested.

The rejections of: (a) Claim 1 under 35 U.S.C. §102(b) over Descalzo et al, and (b) Claim 15 under 35 U.S.C. §103(a) over Descalzo et al, are respectfully traversed.

The Examiner alleges that claim 1 is not novel in view of the disclosure of Descalzo et al. In making this rejection, the Examiner states that silylated organic compounds are disclosed in said document (on line 1 of page 563).

Descalzo et al discloses a method for a fluoride determination in water based on the specific reaction of fluorhydric acid with a MCM-41 solid matrix (mesoporous silica solid matrix) functionalized with fluorescent or coloimetric signaling units. The mesoporous MCM-41 can be first functionalized with 3-aminopropyltriethoxysilane in refluxing toluene, this amino functionalized solid is then reacted with a) 9-anthraldehyde; b) lissamine rhodamine  $\beta$  sulfonyl chloride and c) 4-{2-[4-(dimethylamino)phenyl]diazenyl}benzoic acid, thus giving functionalized solids S1, S2, and S3 (see scheme 1).

However, Descalzo et al does not disclose nor suggest the claimed method wherein a silylated *organic* compound is used *in solution* for detecting and/or measuring the concentration of fluoride or hydrogen fluoride in a sample.

As shown in Table 1 of Descalzo et al, the analysis is based on the reaction of fluoride with functionalized *solids* S1, S2 and S3 (see Scheme 1) which are essentially mineral compounds and *not* organic compounds as the silylated organic compounds of claim 1.

Moreover, the functionalized solids of Descalzo et al are *not in solution* as demonstrated on page 562, right column, third paragraph, said solid are in *suspension* and not in solution. Moreover, as mentioned on page 562, right column, 11<sup>th</sup> line from the bottom “Functionalized *solids* S1, S2 and S3 can also be obtained in a monolithic conformation” clearly such solids cannot be in solution.

With respect to Claim 15, in addition to the foregoing, Applicants submit that Descalzo et al fails to disclose or suggest a kit for any purpose, much less the claimed purpose. Therefore, the rejection over Claim 15 is without merit.

In view of the foregoing, withdrawal of these grounds of rejection is requested.

The rejections of Claims 15-26 under 35 U.S.C. §103(a) over Salari et al or Tallent et al are respectfully traversed.

The Examiner alleges that Claims 15 to 26 are obvious in view of Salari et al or Tallent et al. Applicants disagree and note that there is absolutely no suggestion in these references to combine in a kit a silylated organic compound and detection means for detecting in aqueous solution, the appearance of the desilylated organic compound or the disappearance of the silylated organic compound. For example, in Tallent et al a first silylated compound (bis(tri-methylsilyl acetanide) is used to silylate lipopolysates (thus giving a second silylated compounds) for GLC. Thus, clearly in Tallent et al the measuring means (GLC) are used to detect the appearance of a silylated compound and not the appearance of a desilylated compound or the disappearance of a silylated compound as in the kit of the present invention (claim 15).

In view of the silence of Salari et al and Tallent et al of the kit of the present invention, Applicants request that these grounds of rejection be withdrawn.

Finally, Applicants note that the Examiner failed to acknowledge consideration of reference AW (Descalzo, et al), listed on Form PTO-1449 filed on February 10, 2005, and reference AAG (Choi, et al), listed on Form PTO-1449 filed on May 9, 2005. Applicants kindly request that the Examiner acknowledge consideration of the same by providing them with an initialed Form PTO-1449 **submitted herewith** listing this reference.

Applicants submit that the present application is in condition for allowance. Early notification to this effect is respectfully requested.

Respectfully submitted,

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